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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,205	11/25/2000	Jamie M. Grooms	TB-1041B	3721

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EXAMINER

SNOW, BRUCE EDWARD

ART UNIT	PAPER NUMBER
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3738

22

DATE MAILED: 02/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/722,205

Applicant(s)

GROOMS ET AL.

Examiner

Bruce E Snow

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 December 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 45-64 is/are pending in the application.
- 4a) Of the above claim(s) 46-51, 58, 59, 63 and 64 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 45, 52-57 and 60-62 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

The priority as claimed is approved. It is noted that the elected species shown figures 12A-12D is not supported in USSN 08/920,630, therefore the earliest date is the filing date of the PCT/US98/17769.

### ***Election/Restrictions***

Claims 46-51, 58-59, 63-64 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 18.

Regarding claims 46-51 and 63-64, the elected embodiment is constructed by an alternate method of production to produce unitary implants and not assembled, stacked, joined, etc. See specification page 19, lines 20 et seq.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 45 and 52-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 45, line 6, "said surface" is ambiguous to which surface.

Regarding claim 45, "angling toward the anterior end" is not understood.

Regarding claim 45, does "angling toward the anterior end" describe all three, projections, ribbing, and teeth; or just one teeth?

Regarding claim 45, what is the difference between projection, ribbing, or teeth. Please direct to specification for support for all. What does the elected embodiment have?

### ***Specification/Drawings***

The amendment filed 12/8/03 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The proposed new drawings and corresponding description is new matter not supported by the original disclosure. As previously stated:

*claims 46-51 the specification, while being enabling for the species shown in figure 8A having two pieces juxtaposition to one another, does not reasonably provide enablement for the elected species shown in figure 12A. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Same for claim 47 claiming "two stacked pieces" which is not taught for the elected embodiment.*

**Applicant is required to cancel the new matter in the reply to this Office Action.**

### ***Double Patenting***

Applicant's arguments regarding the double patenting rejection are persuasive and the rejection has been withdrawn. It is interesting to note applicant recognizes the different species, however, still believes it is acceptable to combine them.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 45, 52-57, 60-62 are rejected under 35 U.S.C. 102(e) as being ***clearly anticipated*** by Pafford et al (6,371,988).

Pafford et al teach numerous embodiments of polygonal cortical spinal spacer. Note figures 29-42 teaching a similar embodiment to applicant's figure 1 which is fully capable of being stacked or placed juxtaposition (also see figure 24 for juxtaposition). Note figures 39 and 40 teaching migration resistant projections.

Regarding claim 50, the Examiner interprets figures 29-42 being "substantially diamond shaped".

Regarding "flat end", the projects 205 have a planar or flat forward and rearward facet and a vertically flat side end.

See figure 30, teaching beveled edges.

See figures 40-41 teaching both beveled edges and unbeveled edges.

### ***Response to Arguments***

Applicant's arguments filed 12/8/03 have been fully considered.

Applicant's arguments regarding the Paul et al rejection are persuasive.

Applicant's claim 45 is generic to other embodiments than the elected embodiment and, therefore, has benefit to 8/27/97 filing date. Again, specific elements drawn to the elected embodiment have an earliest date of 8/27/98.

Applicant's arguments regarding the Pafford et al rejection are not persuasive. Pafford et al teaches migration resistant projections 205 which have an angled (sloped) forward facet and an angled rearward facet. Applicant's device has angled rearward facet and a vertical forward facet. Because Pafford et al uses an angled rearward facet as does applicant, the projection is considered "angling toward the anterior end". Regarding the diamond shape, it is the Examiner's opinion that the device is substantially diamond shaped, more so than applicant's device.

### **di·a·mond**

**di·a·mond** (di'e-mend, di'mend) *noun*

2. A figure with four equal sides forming two inner obtuse angles and two inner acute angles; a rhombus or lozenge.<sup>1</sup>

Applicant's arguments regarding Bianchi et al (6,033,438) were persuasive and the rejection has been withdrawn.

Applicant's arguments regarding McIntyre (4,950,296) were persuasive and the rejection has been withdrawn.

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<sup>1</sup> *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction

***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Coates et al (5,88,222) – note the projections shown in figures 13-18.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruce E Snow whose telephone number is (703) 308-3255. The examiner can normally be reached on Mon-Thurs:

Art Unit: 3738

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703)308-2111. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

bes



BRUCE SNOW  
PRIMARY EXAMINER